



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,014	06/15/2001	Michael Smith	1826 (42059-01360)	9634

20350 7590 09/15/2004

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
----------	--------------

2171

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/883,014	Applicant(s) SMITH, MICHAEL	
	Examiner Etienne P LeRoux	Art Unit 2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-11, 14-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-11, 14-16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/28/2004 has been entered.

Claim Status

Claims 8-11, 14-16 and 18-20 are pending in this application. Claims 1-7, 12, 13 and 17 have been cancelled. Claims 8, 15, 16 and 18 are currently amended. Claims 8-11, 14-16 and 18-20 are rejected in this office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8-10, 14-16 and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,430,575 issued to Dourish et al (hereafter Dourish).

Art Unit: 2171

Claims 8 and 15:

Dourish discloses a method for presenting address information to accessing parties in a shared directory environment comprising the steps of:

- detecting a query from at least one entity over a data network seeking a first view of at least one entry in a shared directory [Fig 3, 303 - particular level of customization, col 5, lines 38-55]
- retrieving identification information for the at least one entity, wherein the identification information includes hierarchical information
[<http://macadam.parc.Xerox.com/group1/user1>] associated with the at least one entity
[viewing customized filing structures, col 5, lines 38-55]
- denying access to the first view [user only given access according to levels of customization, col 5, lines 38-55]
- based on the hierarchical information, searching the shared directory to identify all of the at least one entries in the directory which includes the hierarchical information [group 1 and core, col 5, lines 38-55]
- presenting to the at least one entity initiating the query only, all of the identified at least one entries in a second view [group 1 and core, col 5, lines 38-55]

Claim 9:

Dourish discloses wherein the shared directory is configurable for supporting messaging [col 2, lines 25-30].

Art Unit: 2171

Claim 10:

Dourish discloses wherein the entities comprise at least one of at least one person and at least one group [col 5, line 45].

Claim 14:

Dourish discloses wherein the first view is a listing of all entries in the directory and the second view is a copy of the listing with modified selection criteria [Fig 3, core customization level and Group 1 customization level respectively].

Claim 16:

Dourish discloses wherein the data network is the internet and the interface is configured to communicate with web browsers [Fig 1].

Claim 18:

Dourish discloses wherein the server and directory are configured to provide hosted messaging services for a plurality of third parties [Fig 1].

Claim 19:

Dourish discloses wherein the first view comprises a listing of all entries and the at least one additional view is a copy of the listing of all entries with the modified selection criteria [Fig 3, core customization level and Group 1 customization level respectively].

Claim 20:

Dourish discloses wherein the fields are provided for at least one of people entries and group entries in the directory [col 6, lines 19-38].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dourish.

Claim 11:

Dourish discloses the elements of claim 8 as noted above.

Furthermore, Dourish discloses a company name [col 5, line 46].

Dourish does not disclose a company location.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention that a company location was an old and well-known type of designation for a company. Location is an old and well-known means for specifying a particular part of a company which may offices nationally or internationally. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Dourish's disclosure of company to include a company location in order to provide a further designation that the data in a particular file pertains to a particular company in a particular location.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention that it was old and well-known in the computer art to get the advantage of reducing search time by including a file designator that included a company location. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include company location so that a user can save time by quickly selecting the data file of interest because one of

ordinary skill in the art would know what kind of activities occur in a particular company in a particular location.

Response to Arguments

Applicant's arguments filed 5/28/2004 have been fully considered and are partially persuasive. This office action provides above new art rejection in order to advance prosecution so that arguments regarding the semantics of the claim language can be minimized. Applicant's argument in the last paragraph on page 6, states:

Independent claims 8 and 15, as now amended, relate to receiving a query from an entity and using hierarchal information associated with the entity to determine which entries in a shared directory can be used and provided to the entity in a second view, the second view including only the entries from the directory which include the hierarchal information."

Examiner is not persuaded. The above argument presented by applicant can be interpreted as a user is given access to data in a shared directory based on the user profile. Access is based on authentication of the user profile. Such access control based on user profile is old and well-known in the art. Dourish clearly teaches the limitations in claims 8 and 15 as shown in above office action. Dourish is typical of the prior art which discloses community based, shared databases. Those within the community have access to the shared database and those without the community are excluded from access. The prior art discloses many variations on a user profile such as name, location, company division, field of technical interest/expertise.

Art Unit: 2171

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620.

The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux

September 9, 2004


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100